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PATENT
Attorney Docket No. 020375-021400US

TOWNSEND and TOWNSEND and CREW LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Adam Coyle

Application No.: 09/713,770

Filed: November 16, 2000

For: CARD-BASED SYSTEM AND
METHOD FOR ISSUING
NEGOTIABLE INSTRUMENTS

Confirmation No. 3444

Examiner: Kelly S. Campen

Technology Center/Art Unit: 3624

APPELLANTS' AMENDED BRIEF
UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on July 26, 2006 and to the Notification of Non-Compliant Brief mailed on March 5, 2007, for the above-referenced application, Appellants submit this Amended Brief on Appeal.

1. REAL PARTY IN INTEREST

First Data Corporation is the real party in interest as the assignee of the above-identified application.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. STATUS OF CLAIMS

Claims 1-21, 23, 32 and 39 have been cancelled, leaving claims 22, 24-31 and 33-38 as currently pending. Such pending claims stand finally rejected pursuant to an Office Action dated May 1, 2006. The rejections of the pending claims are believed to be improper and are the subject of this appeal.

4. STATUS OF AMENDMENTS

Appellant filed an Amendment on August 29, 2006 under 37 CFR 44.33 and 1.116, to put the claims in better form for consideration on appeal. Such Amendment was entered. No other amendments have been proposed or entered subsequent to the Office Action mailed on May 1, 2006.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Appellant's invention is a method and system for issuing prepaid negotiable instruments by a non-banking institution (Application, p. 2, ll. 12-14). While many consumers use traditional banking relationships, there are some consumers in financial circumstances that make such relationships impractical or undesirable. This group of consumers is sometimes identified as part of a cash-based society, and they avoid traditional banking relationships because of worry about garnishments, inconvenience, or disrespectful service (p. 1, ll. 27-32)

Embodiments of the invention address this problem by establishing an uninsured, prepaid account at a non-banking institution. The use of an uninsured account permits the non-banking institution to provide financial services to cash-based customers without the need for

qualifying/approval barriers, high costs, and intricate fee and reporting obstacles that are associated with a traditional banking relationship (p. 5, ll. 4-8). The account is able to receive deposits of funds from or on behalf of the account holder (p. 5, ll. 8-12). Funds may then be accessed from the account through the issuance of prepaid negotiable instruments (p. 9, ll. 7-9).

Deposits may be made into the prepaid account using a separate account at a banking institution. Such deposits made to the banking account are then automatically swept into the prepaid account where they can be accessed by the account holder (p. 2, ll. 16-24). This not only permits the account holder to have the advantage of direct deposits (e.g., through the use of ACH transfers), but those funds become immediately available at the prepaid account where they may be used without the reporting and other restrictions attendant to a traditional banking relationship. (p. 6, ll. 6-20).

Since the prepaid account is set up at a non-banking institution, it may be an anonymous account (there is no personal information concerning the account holder), and the funds may accessed (through the issuance of prepaid negotiable instruments) without the use of personal information (e.g., the account holder may use a PIN rather than personal information to access the account) (p. 3, ll. 14-23).

Independent Claims 22 and 37

Independent claim 22 recites a system for issuing prepaid negotiable instruments to account holders. An overview of the system is shown in Figs. 1, 2, 3 and 8a and 8b. The system includes a database (Fig. 3, elements 312, 316) for storing in relation to a prepaid account 102, an account identifier and a balance that represent funds deposited as prepaid negotiable instruments (p. 9, ll. 7-9; p. 10, ll 1-3; p. 12, ll 1-6). The prepaid account is maintained by a non-banking institution and is thus not FDIC insured (p. 5, ll. 1-2). A transaction terminal (element 112 or 116) includes a card reader (elements 811 or 816) for reading the account identifier, an input device (elements 306 or 814) for entering the amount of a negotiable instrument (p. 15, ll. 13-23), and a printer (elements 304, 818 or 844) for printing the amount of the negotiable instrument. A server system (elements 211, 214) receives the account identifier, accesses the database to determine the balance in the prepaid account, authorizes a negotiable instrument if

there is a sufficient balance, and debits the prepaid account (p. 9, l. 10 through p.10, l. 12). A communications link (element 210) receives data relating to a sweep account maintained by a banking institution, the sweep account for receiving deposits and immediately crediting those deposits to the prepaid account (p. 8, ll. 8-22).

Claim 37 recites a method with steps corresponding to system features of claim 22.

Dependent Claims 24-31, 33-36 and 38

Other embodiments of the invention are recited in the dependent claims 24-36 (which depend from claim 22), and 38 (which depends from claim 37). Each of these claims recite specific limitations in combination with the elements of their respective parent claims.

Claim 24 recites that deposits to the sweep account are direct deposits through an automated clearinghouse (p. 7, ll. 1-18). Claim 25 recites that a card and PIN are used at the terminal in order to request a negotiable instrument (p. 14, l. 28 through p. 15, l. 12). Claim 26 recites that the prepaid account is "anonymous", that the database stores no identifying personal information, and that the server authorizes the negotiable instrument without requiring identifying information, other than the account identifier and PIN (p. 16, ll. 5-8). Claim 27 recites limitations similar to claim 26, but further provides that the anonymous account stores no identifying information other than the account holder name, in order for the name to appear as payee on the issued negotiable instrument (p. 20, ll. 15-16). Claims 28, 35 and 38 recite that the negotiable instrument is issued in the account holder's name and also recite (in claims 28 and 38) that the instrument is preprinted with a restrictive legend requiring identification for cashing (p. 20, ll. 21-22). Claim 29 recites that the negotiable instrument is also preprinted with a restrictive legend setting an upper limit on its face value (p. 20, l. 23). Claims 30 and 31 recite that the transaction terminal is an ATM or, alternatively, a POS terminal (elements 112, 116). Claim 33 recites that the non-banking institution is a Licensed Money Transmitter, requiring a transaction fee which is deducted from the prepaid account for the negotiable instrument (p. 10, ll. 1-11). Claim 34 recites that the server system authorizes the negotiable instrument if there is a sufficient balance to cover the amount of the negotiable instrument and transaction fee (p. 10, ll.

1-3). Claim 36 recites that the balance stored in the prepaid account is limited to a predetermined maximum (p. 16, ll. 23-26).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 22, 24-31, and 33-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US. Patent No. 6,149,055 ("Gatto").

B. Claims 37 and 38 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

7. ARGUMENT

Rejection under 35 U.S.C. §103(a)

For a rejection to be maintained under 35 U.S.C. §103(a), the Examiner is charged with factually supporting a *prima facie* case of obviousness. MPEP 2142. Such a *prima facie* case requires, *inter alia*, that all limitations of the claims be taught or suggested by the cited references and that there be some suggestion or motivation to combine and/or modify the reference teachings as the Examiner proposes. MPEP 2143.

In this instance, the Examiner relies on a single reference, **Gatto**, in rejecting independent claims 22 and 37 under §103(a). **Gatto** discloses an EFT system having central control units 200 and databases 300, which are connected via a communications link 400 to a network of terminals or ATMs 10. At column 5, lines 40 through 49, **Gatto** mentions that the system is capable of generally performing a number of financial transactions, such as "withdrawing cash, traveler's checks, bonds, and other negotiable instruments..."

In the final Office Action, the Examiner states (page 3 of the Remarks) that **Gatto** supports the rejection because it discloses "a database for storing an account identifier, a transaction terminal for issuing negotiable instruments and a server in communication with the database and the transaction terminal (see Abstract, col. 6-8)." The Examiner further states that **Gatto** "does not disclose a means for issuing negotiable instruments," but that it would be obvious "to use a means of issuing the negotiable instrument as Gatto teaches the system of electronic funds may be used to issue negotiable instruments (col. 5, lines 40-45)."

Even if one were to accept, for purposes of argument, that the Examiner's characterization of **Gatto** is correct, Appellant respectfully submits that the Examiner had failed to present a *prima facie* case of obviousness, since **Gatto** clearly does not disclose or suggest all limitations recited in claim 22.

Specifically, the Examiner has not mentioned in the Remarks to the Office Action, nor is Appellant able to find in **Gatto**, any disclosure or suggestion of several specific elements recited in claim 22, such as:

"a database for storing . . . a balance associated with the prepaid account, wherein the balance *represents funds deposited to the prepaid account as advance payment for negotiable instruments*,"

"wherein the prepaid account is *maintained by a non-banking institution and the prepaid account is thus not an FDIC insured account*," and

"a communication link connecting the server system for receiving data from a banking institution, *the data relating to a sweep account maintained by the banking institution for receiving deposits for the account holder and immediately crediting those deposits to the prepaid account*" (emphasis added).

Such elements are part of the inventive combination recited and disclosed by Appellant for carrying out the purpose of the invention. Specifically, Appellant's invention (including the just-referenced combined elements) permits consumers who are cash-based to make deposits into a banking account and then conduct transactions against a prepaid account maintained by a non-banking institution (using prepaid negotiable instruments).

Gatto, as applied, merely discloses and suggests a conventional ATM system, and if anything it teaches away from the present invention by disclosing the use of ATMs in a traditional financial environment, rather than an arrangement (as implemented by Appellant's novel system and method) where deposits are made to a sweep account at a banking institution and are then immediately credited to a prepaid account at a non-banking institution, where the

prepaid account is not an FDIC insured account, and where funds are withdrawn only as negotiable instruments.

Dependent Claims 24-31, 33-36, and 38

As to the dependent claims, the Examiner rejected the claims with the simple statement that the Examiner takes "official notice that it was notoriously well known to use the further limitations of the dependent claims 24-36 as these limitations enhance the usability of the system." Appellant respectfully submits that this basis for rejection is not supported by either the courts or established PTO practice. In fact, the courts have clearly stated that when common knowledge or common knowledge is cited without documentary evidence, the Examiner "must provide specific factual findings predicated on sound technical and scientific reasoning," and that conclusory statements are not proper. MPEP 1244.03B. Also, see *In re Zurko*, 258 F. 2d 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) and *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). The Examiner's basis for taking official notice does not meet these standards.

Furthermore, the Examiner is not permitted to take official notice of facts without cited references unless "the facts asserted to be well known are not capable of instantaneous and unquestionable demonstration as being well known." MPEP 2144.03. See also *In re Ahlert*, 424 F2d. 1088, 165 USPQ 418 (CCPA 1070). Appellant's dependent claims recited several novel features, such as (by way of example only) the prepaid account database recited in claim 26 storing "no identifying personal information concerning the account holder, and wherein the server system authorizes issuance of a negotiable instrument without requiring identifying information concerning the account holder other than the account identifier and the PIN." This specific limitation, as well as the other specific limitation (e.g., referred to in the Summary of Claimed Subject Matter" above), in dependent claims 24-31, 33-36, and 38 are not "capable of instantaneous and unquestionable demonstration as being well known," and thus Appellant respectfully submits that this further supports the point in that official notice was not properly taken.

The Examiner has also stated in the Final Office Action that the limitations of all dependent claims are "taken to be admitted to be prior art because applicant failed to traverse the

examiner's assertion of official notice" (page 4 of the Remarks). As pointed out in the previous response, Appellant does believe that the Examiner's assertion was traversed, at least in part. For example, in the response to the Office Action (dated August 10, 2005) where the Examiner's "official notice" was first mentioned, Appellant incorporated several of the limitations of the dependent claims (of which the Examiner took "official notice") and incorporated them into independent claim 22 and argued the patentability of the amended claims.

Furthermore, the Office Action (dated August 10, 2005) in which "official notice" was first taken was a final rejection (Appellant subsequently filed a Request for Continued Prosecution in order to have further consideration of the claims). Appellant notes the PTO's own policy that using unsupported official notice "should be rare when an application is under final rejection or action." MPEP 2144.03A.

Even if one were to accept that the Examiner has properly taken "official notice" of the specific, individual limitations of the dependent claims (which, of course, the Appellant believes was not proper), Appellant respectfully submits that Examiner has not pointed to any teaching or suggestion that a combination be made of those elements with the other elements of their respective parent claims. The Examiner is not permitted to merely state that all elements of a claim are known in the art, but rather must articulate some suggestion or motivation to combine and/or modify the reference teachings as the Examiner proposes. MPEP 2143.01. Nowhere has the Examiner pointed out a suggestion or motivation (either in **Gatto** or in "official notice") that the elements of the dependent claims be combined (with the elements of the independent claims) in the novel and inventive way as done by Appellant, or to accomplish the important purpose of Appellant's invention.

Rejection under 35 U.S.C. §112)

The Examiner states (page 2 of the Remarks) that in claim 37 there is "not positively recited a method step of issuing prepaid negotiable instruments" and that in claim 37 "[l]ines 10-17 appear to be directed towards providing a server system where a negotiable (not prepaid) instrument is issued."

As to the first statement, Appellant respectfully submits that that claim 37 does in fact recite several clear method steps, such as the steps beginning with the phrases "storing in a database...", "issuing a negotiable instrument...", "maintaining a sweep account...", and "upon any such deposit, immediately debiting the sweep account..".

As to the Examiner's second statement that "[l]ines 11-16 appear to be directed towards providing a server where a negotiable (not prepaid) instrument is issued," as best understood by Appellant, the Examiner appears to believe that the term "prepaid" has been omitted in the "providing a server system" step. Appellant points out that if this omission is in fact the bases for the rejection, the omission was corrected in a previous Response (dated February 15, 2006), where the phrase "so that the negotiable instrument issued at the transactional terminal is *prepaid*" (emphasis added) was amended to include the term "prepaid," and such term does now appear in the recited step.

8. CONCLUSION

For these reasons, it is respectfully submitted that the rejection should be reversed.

Respectfully submitted,

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9. CLAIMS APPENDIX

1-21. (Cancelled)

22. (Previously presented) A system for issuing prepaid negotiable instruments to an account holder, comprising:

a database for storing, in relation to a prepaid account of the account holder, an account identifier and a balance associated with the prepaid account, wherein the balance represents funds deposited to the prepaid account as advance payment for negotiable instruments, wherein withdrawals against the prepaid account are made only by issuance of negotiable instruments, and wherein the prepaid account is maintained by a non-banking institution and the prepaid account is thus not an FDIC insured account;

a transaction terminal for issuing negotiable instruments, the terminal including a card reader for reading a card having data thereon representing the account identifier, an input device for entering the amount of the negotiable instrument, and a printer for printing the amount on the negotiable instrument;

a server system in communication with the database and the transaction terminal, the server system receiving the account identifier in response to the card being read at the transaction terminal, accessing the database to determine the balance within the prepaid account associated with the account identifier, authorizing a negotiable instrument to be issued at the terminal if there is a sufficient balance within the account to cover the amount of the instrument, and debiting the prepaid account by the amount of the issued negotiable instrument; and

a communication link connecting the server system for receiving data from a banking institution, the data relating to a sweep account maintained by the banking institution for receiving deposits for the account holder and immediately crediting those deposits to the prepaid account.

23. (Canceled)

24. (Previously presented) The system of claim 22, wherein the deposits received at the sweep account are direct deposits through an automated clearinghouse (ACH) system.

25. (Previously Presented) The system of claim 22, wherein a personal identification number (PIN) is associated with the card, wherein the card is presented by the account holder at the transaction terminal, and the PIN is entered at the input device of the terminal in order for the account holder to request issuance of a negotiable instrument.

26. (Previously Presented) The system of claim 25, wherein the account is an anonymous prepaid account, wherein the database stores no identifying personal information concerning the account holder, and wherein the server system authorizes issuance of a negotiable instrument without requiring identifying information concerning the account holder other than the account identifier and the PIN.

27. (Previously Presented) The system of claim 25, wherein the account is an anonymous prepaid account, wherein the database stores no identifying personal information concerning the account holder other than the account holder name to appear as payee on the negotiable instrument, and wherein the server system authorizes issuance of a negotiable instrument without requiring identifying information concerning the account holder other than the account identifier and the PIN.

28. (Previously Presented) The system of claim 27, wherein the negotiable instrument is issued in the name of the account holder, and wherein the negotiable instrument is preprinted with a restrictive legend requiring identification for cashing the negotiable instrument.

29. (Previously Presented) The system of claim 28, wherein the negotiable instrument is further preprinted with a restrictive legend setting an upper limit for its face value.

30. (Previously Presented) The system of claim 22, wherein the transaction terminal is an automated teller machine (ATM).

31. (Previously Presented) The system of claim 22, wherein the transaction terminal is a point of sale (POS) terminal.

32. (Canceled)

33. (Previously Presented) The system of claim 22, wherein the non-banking institution is a Licensed Money Transmitter (LMT), wherein the LMT requires a transaction fee for issuing the negotiable instrument, and wherein the transaction fee is deducted from the account when the negotiable instrument is issued.

34. (Previously Presented) The system of claim 33, wherein the server system authorizes a negotiable instrument to be issued at the terminal if there is a sufficient balance within the account to cover the amount of the transaction fee in addition to the amount of the negotiable instrument.

35. (Previously Presented) The system of claim 22, wherein the printer prints the name of the account holder on the negotiable instrument so that the negotiable instrument is payable to the account holder.

36. (Previously Presented) The system of claim 35, wherein the balance associated with the account and stored in the database is limited to a predetermined maximum value.

37. (Previously Presented) A method for issuing prepaid negotiable instruments to an account holder, comprising:

storing in a database and in relation to an account of the account holder, an account identifier and a balance associated with the account, wherein the balance represents funds deposited to the account as advance payment for negotiable instruments, wherein withdrawals against the account are made only by issuance of negotiable instruments, and wherein the account is a prepaid account maintained by a non-banking institution;

issuing a negotiable instrument at a transaction terminal, the terminal including a card reader for reading a card having data thereon associated with the account identifier, an input device for entering the amount of the negotiable instrument, and a printer for printing the amount on the negotiable instrument;

providing a server system in communication with the database and the transaction terminal, the server system receiving an account identifier in response to a card being read at the transaction terminal, accessing the database to determine the balance within the account associated with the account identifier, authorizing a negotiable instrument to be issued at the terminal if there is a sufficient balance within the account to cover the amount of the instrument, and debiting the account by the amount of the negotiable instrument so that the negotiable instrument issued at the transactional terminal is prepaid;

maintaining a sweep account at a banking institution for receiving direct deposits for the account holder; and

upon any such deposit, immediately debiting the sweep account by the amount of the deposit and crediting such deposit to the balance stored in the database for the prepaid account.

38. (Previously Presented) The method of claim 37, further comprising printing the name of the account holder on the negotiable instrument as the payee and printing a restrictive legend requiring identification in order to cash the negotiable instrument.

39. (Canceled)

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10. EVIDENCE APPENDIX

None

11. RELATED PROCEEDINGS APPENDIX

None

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